

## REMARKS

Applicant has carefully reviewed the arguments presented in the Office Action and respectfully requests entry of the amendment and reconsideration of the application, as amended, in view of the remarks presented below.

Claims 115, 119, 230, and 286-290 have been amended. Claims 1-114, 122-229, 233, 235, and 237-285 have been canceled. Thus claims 115-121, 230-232, 234, 236 and 237-297 remain pending in the application.

Claims 115-121, 230-232, 234, 236 and 286-297 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Barkan (International Publication No. WO 98/17042) in view of "Network Design Manual: Storing and Forwarding With SMTP and Message Transfer Agents," Feb 23, 1999 (Hereafter, NDM). Applicant respectfully traverses these rejections.

The crux of the Examiner's rejections apparently is his belief that Barkan discloses the step of "storing at the server at least a portion of a dialog generated during the transmission of the message between the server and the destination address [see p.23-24, steps j-h, p.29-30, 31-32, 34]." Office Action at 18, ll. 4-6. Applicant respectfully disagrees with the Examiner.

First, it is axiomatic that the entire claim be examined in its entirety. This means that all the words of an element or limitation must be considered when evaluating the teachings of a prior art reference. Second, it appears that the Examiner is resorting to improper hindsight reconstruction to formulate his objections to the claims. The Examiner seems to be reciting the same rejections over and over without a careful re-examination of the claims and cited art, even when Applicant points out the deficiencies in the cited art.

Claim 115 was amended to clarify that the server transmits a message to a recipient. Further, claim 115, was amended to recite the step of: "storing at the server at least a portion of a mail transport protocol dialog generated by the server and recipient during the transmission of the message between the server and the recipient." Independent claim 230, as currently amended, contains similar language: "creating an electronic attachment at the second server including the identity and address of the sender and the identity and address of the second server and the identity and address of the destination server and at least a portion of a mail transport

protocol dialog generated by the second server and the destination server during the transmission of the message between the second server and the destination server."

Contrary to the Examiner's assertion, Barkan neither teaches nor suggests storing at least a portion of a mail transport protocol generated by the server and recipient or creating an electronic attachment including at least a portion of a mail transport protocol dialog that was generated by the second server and the destination server during transmission of a message between the server and recipient or the second server and destination server. The pages in Barkan cited by the Examiner do not contain the words "mail transport protocol dialog." In fact, they do not contain the word "dialog" at all. Nor do they contain the words "store" or "storing." Applicants believe that the Examiner has used impermissible hindsight reconstruction to obtain Applicant's claimed language.

A dialog, as that term is understood by one skilled in the relevant art, is a list of commands and responses exchanged between an outgoing server and a destination address or server to transmit a message. *See, e.g., "Network Design Manual: Storing and Forwarding With SMTP and Message Transfer Agents,"* attached hereto as Appendix A. The dialog is separate from the transmission of the message itself. The commands and responses are part of the process of actually transmitting the message. As recited by Applicant in claims 115 and 230, Applicant either stores at least a portion of the commands and responses exchanged between servers or creates an attachment with at least a portion of those commands. Barkan simply does not teach or suggest either of these steps.

Barkan discloses an email system that uses various encryption methods and public and private keys. Information is passed back and forth between senders and recipients. However, nowhere does Barkan teach or suggest storing at least a portion of a mail transport protocol dialog, that is, the commands and responses that are exchanged between the server and destination address as part of the mail transport process generated during transmission of the message between the server and destination address for subsequent proof of the message and the delivery of the message by the server to the destination address, as is claimed in amended claim 115.

For example, Barkan, at page 23-24, in step d. teaches "a fourth message including a notice that an E-mail message was sent to a second user, the CRC or hash of the message, the identification of the intermediary 71 and the serial number or message identification." There is no teaching of storing at least part of a mail transport protocol dialog. Barkan clearly states that the LRM transmission program prepares a notification that an E-mail message was sent. This is different from storing at least part of a mail transport protocol dialog which is an exchange of commands between sending and receiving servers.

In step e., Barkan merely teaches sending various messages to various users, with no mention of storing at least part of a mail transport protocol dialog, or using at least a portion of a mail transport protocol dialog as contents of the message. For example, step e discloses a third message and a fourth message. Both of these messages are prepared by the LRM program. Such messages are not claimed by Applicant. In step f., Barkan teaches presenting a second user with information relating to a received message, but there is no mention of storing at least part of a mail transport protocol dialog. As is plainly apparent from reading step f of Barkan, the information relating to the received message is presented to the recipient for use by the recipient in step g, where the second user 2 (the recipient) is given a choice of accepting or not accepting the message. There is simply no recitation of storing at least part of a mail transport protocol dialog.

Similarly, step g. discloses encrypting a fourth message with a private key of a second user to create a fifth message, the fifth message being a receipt signed by the second user with his key, including the message identification and the CRC or hash relating to the contents of the message. There is no disclosure of storing at least a portion of a mail transport protocol dialog, or using at least a portion of a mail transport protocol dialog as contents of the message. The same applies to the disclosure of step h.

Similarly, Barkan at pages 29-30, 31-32 and 34 fails to disclose or even suggest storing at least part of a mail transport protocol dialog or using at least a portion of a mail transport protocol dialog as contents of the message. Barkan teaches a system using multiple messages and public and private key encryption, a complicated system that is simply not required using Applicant's claimed invention. Moreover, using Applicant's invention of amended claim 115

provides proof of the message, and that the message was delivered by recording the mail transport protocol dialog generated during transmission of the message, thus avoiding all of the additional messages and complicated encryption technology of Barkan.

Moreover, while NDM does teach using conventional network communication protocols such as SMTP and the like to transmit electronic documents, NDM does not teach or suggest storing at least a portion of a mail transport protocol dialog generated by those protocols during transmission of the document. Applicant does not deny that communication protocols are used to communicate information over a network. However, using a protocol to communicate documents in a network is not the same as storing at least a portion of the communications between servers and destinations that occur as the result of using that protocol.

While persons skilled in the art would have been aware of the flow of information that is part of the protocol, Applicant alone recognized the importance of storing the dialog that occurs between a server and recipient that is generated when using a mail transport protocol such as SMTP, as is claimed by Applicant, for later use in proof of the message and proof of the delivery of the message. For these reasons, Applicant submits that claim 115 is patentable over the cited art and respectfully requests that the rejection be withdrawn and that claim 115 and its dependent claims, be allowed. (Emphasis added).

Similar to claim 115, claim 230 recites creating an electronic attachment at a second server including the identity and address of the sender and the identity and address of the second server and the identity and address of the destination server and at least a portion of a mail transport protocol dialog generated by the second server and the destination server during the transmission of the message between the second sever and destination server. As described with reference to claim 115, neither Barkan nor NDM, taken alone or in combination, teach or even suggest the novel method of claim 230. Further, none of the art, alone or in combination, teach or suggest creating an electronic attachment including at least a portion of a mail transport protocol dialog before any authentication of the message, as is claimed in claim 230. Accordingly, Applicant submits that claim 230 is patentable over the cited art and requests that the rejection be withdrawn and that claim 230 and the claims dependent therefrom be allowed.

In summary, while Barkan does teach a system of multiple messages transmitted between various servers, none of those messages are formed using at least a portion of a mail transport protocol dialog, that is, none of Barkan's messages, keys or other encryption devices store or use any portion of the actual mail transport protocol dialog exchanged by the servers disclosed by Barkan. The mail transport protocol dialog recited by Applicant in claims 115 and 230 is not part of any message that is transmitted in Barkan. Moreover, while NDM does teach using an SMTP protocol, NDM fails to teach or even suggest storing or using any portion of the commands and responses exchanged between servers using the SMTP protocol to transmit a message.

In short, none of the art cited by the Examiner, alone or in combination, recites the unique step of storing at least a portion of a mail transport protocol generated by a server and a recipient (or destination server), as claimed by Applicant. There is no teaching, suggestion, or even hint of a motivation to combine the teachings of the various art cited by Examiner of the unique steps claimed by Applicant.

Accordingly, Applicant respectfully submits that claims 115 and 230, and all of the claims dependent therefrom are patentable over the art of record, taken alone or in combination, and asks that the rejections be withdrawn and that those claims be allowed.

## CONCLUSION

Applicant has carefully reviewed the arguments presented in the Office Action and respectfully requests reconsideration of the claims in view of the remarks presented. In light of the above amendments and remarks, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Should the Examiner have any questions concerning the above amendments and arguments, or any suggestions to obtain allowance, Applicant requests that the Examiner contact Applicant's attorney, John K. Fitzgerald, at 310-824-5555.

The Commissioner is authorized to credit any overpayment or charge any additional fees in this matter to our Deposit Account No. 06-2425.

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Respectfully submitted,

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